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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	94002596
Party	Applicant Masayoshi Takayama
Correspondence Address	DAVID A PLUMLEY CHRISTIE PARKER HALE LLP PO BOX 29001 GLENDALE, CA 91209 UNITED STATES pto@cph.com, david.plumey@cph.com
Submission	Reply in Support of Motion
Filer's Name	David A. Plumley
Filer's e-mail	pto@cph.com, david.plumley@cph.com
Signature	/David A. Plumley/
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TRADEMARK
Docket No. 110.2*2/T605

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MASAYOSHI TAKAYAMA, Applicant, v. D'AMICO HOLDING COMPANY, Registrant.	Concurrent Use No. 94002596 **APPLICANT MASAYOSHI TAKAYAMA'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT** Mark: MASA Serial No.: 76/685,731 Filed: January 14, 2008

REPLY IN SUPPORT OF TAKAYAMA'S MOTION FOR SUMMARY JUDGMENT

I. Introduction

In opposing Takayama's motion for summary judgment, D'Amico concedes that Takayama is entitled to a concurrent use registration, indicating that the only issue remaining is the geographic scope to be afforded that application. *See* Defendant's Response to Plaintiff's Motion for Summary Judgment ("D'Amico's Response") at page 3 ("What remains in dispute are the registrable rights to the remainder of the United States possessed by each party.") Takayama contends that the Coexistence and Settlement Agreement (the "Coexistence Agreement") is unambiguous in permitting Takayama to use the MASA mark "in the area comprising the United States with the exceptions of the state of Minnesota, the area within fifty miles of Minneapolis, Minnesota, and the state of Florida," as set forth in Takayama's concurrent use application. D'Amico asserts that the Coexistence Agreement should be interpreted to limit Takayama's use of the MASA mark to "New York and 50 miles around New York City." *See* D'Amico's

Response, page 1. D'Amico further argues that Takayama's registration should be limited because his use of the MASA mark has been static.

However, despite D'Amico's arguments, the Coexistence Agreement is unambiguous in permitting Takayama to use the MASA mark as set forth in the present application. There being no ambiguity, there is no need to rely on the extrinsic evidence submitted by D'Amico in support of its argument that Takayama's use of the mark has been static. Moreover, even if D'Amico's evidence is considered, it fails to support any geographic restrictions beyond those already stated in Takayama's concurrent use application.

II. The Coexistence Agreement is Unambiguous

As noted by D'Amico, whether the Coexistence Agreement is interpreted under Minnesota law or New York law, the result is the same. Furthermore, Takayama agrees that the threshold determination as to whether an ambiguity exists is a question of law to be resolved by the court. *Agor v. Board of Educ.*, 981 N.Y.S.2d 485, 487 (N.Y.A.D. 3 Dept. 2014). Under New York law, "[c]ontract language is ambiguous when it is reasonably susceptible of more than one interpretation and there is nothing to indicate which meaning is intended, or where there is contradictory or necessarily inconsistent language in different portions of the instrument." *Natt v. White Sands Condo.*, 943 N.Y.S.2d 231 (N.Y.A.D. 2 Dept. 2012). Furthermore, a "written agreement that is complete, clear and unambiguous on its face must be enforced according to the plain meaning of its terms." *Greenfield v. Philles Records*, 98 N.Y.2d 562, 780 N.E.2d 166, 750 N.Y.S.2d 565 (N.Y. 2002). Moreover, it is "established precedent that silence does not equate to contractual ambiguity." *Greenfield* at 573 (citing *Reiss v. Financial Performance Corp.*, 97 N.Y.2d 195, 199 (2001)).

As the premise for its argument that the Coexistence Agreement is ambiguous, D'Amico relies on two statements, purportedly taken from the Coexistence Agreement. However, D'Amico grossly misstates the pertinent terms of the Coexistence Agreement. Specifically, D'Amico asserts that the first paragraph of the Coexistence Agreement "established the

geographic territory for Applicant's use of his alleged MASA mark as New York and 50 miles around New York City," and that the second paragraph of the Coexistence Agreement "established the geographic territory for D'Amico's use of its MASA and MASA & Design marks as Minnesota, 50 miles around Minneapolis, and Florida." *See* D'Amico's Response, the first and second bullet points of its "Statement of Disputed Facts." However, rather than stating areas of *permitted* use as argued by D'Amico, the first and second numbered paragraphs of the Coexistence Agreement set forth areas of *prohibited* use. According to the first paragraph: [redacted] *See* the Declaration of David Plumley submitted in support of Takayama's Motion for Summary Judgment ("the Plumley Declaration"), Exhibit A. According to the second paragraph: [redacted] *Id.*

The intended meanings of the first and second numbered paragraphs have only one reasonable interpretation as to Takayama's permitted area of geographic use—that Takayama is free to provide restaurant services throughout the United States with the exceptions of Minnesota, within 50 miles of Minneapolis, and Florida. There is no contradictory or inconsistent language in the Coexistence Agreement, and in fact, the Coexistence Agreement specifically contemplates such coexistence in the rest of the United States. For example, the agreement itself is captioned a "*Coexistence* and Settlement Agreement." S*ee* Plumley Declaration, Exhibit A (emphasis added). The Coexistence Agreement is premised on the desire of the parties [redacted] *Id.*, at eighth recital. The Coexistence Agreement sets forth that in view of each party's agreement [redacted] *Id.* at paragraph 4. The Coexistence Agreement further sets forth [redacted]

[redacted] *Id.* at paragraphs 5 and 6. Had the parties intended for either party's use of its respective mark to be further restricted beyond those specific geographic regions mentioned, paragraphs 1 and 2 of the Coexistence Agreement would have set forth such further restrictions. Therefore, rather than being silent or ambiguous as argued by D'Amico, the Coexistence Agreement is clear and unambiguous as to the geographic scope of permitted use.

III. Takayama's Use of the MASA Mark has Not Been Static

D'Amico argues that the geographic scope of Takayama's rights should be limited because his use has purportedly been "static." However, despite any similarities in facts between the "static use" cases cited by D'Amico and the present dispute, a glaring omission from the cases cited by D'Amico is that in none of those cases was there an agreement between the parties addressing permitted use. Rather than the "static use" cases cited by D'Amico, the case most closely aligned with the facts here is *Holmes Oil Co., Inc. v. Myers Cruizers of Mena, Inc.*, 101 U.S.P.Q. 2d 1148, 1150 (TTAB 2011). There, relying on a coexistence agreement between the parties, the Board permitted the application at issue to proceed to registration based on the inclusion of specific limitations including geographic restrictions, and even though the excepted user owned a geographically unrestricted registration. *Id.* at 1148.

Furthermore, even if the "static use" cases were relevant here, the evidence relied upon by D'Amico fails to support its position. In fact, much of D'Amico's evidence contradicts its position. For example, D'Amico argues that Takayama has not expanded his use of the MASA mark beyond the first location in New York, and that there are no news articles to support any expansion in Takayama's use of the MASA trademark. However, D'Amico introduces two news articles that discuss Takayama's actual expansion of the MASA trademark to Las Vegas. *See* the Declaration of Bradley Walz, Exhibits 12 and 13, articles discussing Takayama's expansion beyond the original New York MASA restaurant to include the "Bar MASA" restaurant in Las Vegas. D'Amico also submits evidence of Takayama's plans for further expansion. *Id.*, Exhibits

6 and 10, records from the Patent and Trademark Office showing Takayama's intent to use the BAR MASA and KAPPO MASA variations of the MASA trademark.

D'Amico submits evidence that Takayama has filed applications for other trademarks for use with restaurant services (*Id.*, Exhibits 6-11), urging the Board to conclude that Takayama's pursuit of restaurants under other trademarks is evidence that he has abandoned any further plans for MASA. Not surprisingly, D'Amico cites no authority for the apparent position that a party is entitled to but one trademark. In introducing this evidence, D'Amico also ignores that two of the pending applications identified are for the BAR MASA and KAPPO MASA variations on the MASA trademark. *Id.*, Exhibits 6 and 10. D'Amico submits evidence that Takayama's website is out of date, here urging the Board to infer that Takayama has abandoned any expansion of the MASA trademark. *Id.*, Exhibits 3-5. However, even if an out-of-date website could support an inference of abandonment, D'Amico has effectively refuted such an inference by submitting evidence that Takayama has expanded his services beyond New York to include the Las Vegas "Bar MASA" restaurant. *Id.*, Exhibits 12 and 13. Rather than being static, Takayama's use of the MASA mark has expanded, and Takayama is entitled to the registration he seeks.

IV. Conclusion

The Coexistence Agreement between the parties unambiguously sets forth guidelines by which the parties' trademarks may coexist, and D'Amico has failed to introduce any evidence to the contrary. Because Takayama's concurrent use application is consistent with the terms of the Coexistence Agreement, there are no triable issues of fact. Final judgment should be entered permitting Takayama's application to proceed to registration.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

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By /David A. Plumley/

David A. Plumley
Attorneys for Applicant
Christie, Parker & Hale, LLP
P.O. Box 29001
Glendale, CA 91209-9001
Telephone: (626) 795-9900
Facsimile: (626) 577-8800
Email: pto@cph.com; david.plumley@cph.com

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CERTIFICATE OF SERVICE

I certify that on May 7, 2014, a true and correct copy of the foregoing **APPLICANT MASAYOSHI TAKAYAMA'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT [REDACTED]** and a true and correct copy of the parallel **APPLICANT MASAYOSHI TAKAYAMA'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT [CONFIDENTIAL]** are being served by electronic mail, to:

Bradley J. Walz
WINTHROP & WEINSTINE, P.A.
225 South Sixth Street, Suite 3500, Capella Tower
Minneapolis, MN 55402
Telephone: (612) 604-6400
Facsimile: (612) 604-6800
Email: *trademark@winthrop.com;*
bwalz@winthrop.com
jrezac@winthrop.com

Attorneys for Registrant, D'Amico Holding Company

By /Jennifer Guerra/
Jennifer Guerra
Christie, Parker & Hale, LLP
P.O. Box 29001
Glendale, CA 91209-9001
Telephone: (626) 795-9900
Facsimile: (626) 577-8800
Email: pto@cph.com

DAP/jhg